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3611

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the U.S. Patent Application of  
Alan A. SIEGEL and Rod LOWENSTEIN

Serial No.: 09/659,525

Date Filed: September 12, 2000

For: Apparatus and Method for the Distribution of Consumer Product Information

Examiner: Cassandra Hope Davis

Art Unit: 3611

Our Docket No.: P-5

Mail Stop AF, Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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APR 26 2004

REQUEST FOR WITHDRAWAL OF FINAL OFFICE ACTION

**GROUP 3600**

SIR:

An Office Action was mailed December 16, 2003, rejecting claims 1, 3, 8, 9, 11, 15, 16, 18 and 22. Claims 6, 7, 14 and 21 have been indicated as being objected to, but claims 1, 3, 8, 9, 11, 15, 16, 18 and 22 have been rejected as being fully anticipated by U.S. Patent No. 5,217,056 to Ritter, for reasons set forth in paragraph in paragraph 2 on page 2 of the Office Action. In making this rejection, the Examiner has made a distinction between an "optical memory," on the one hand, and a "CD-ROM," and "optical disk," on the other hand. However, the Ritter reference, which the Examiner used as a complete anticipating reference, is directed to a protective holder for thin-walled cards, such as bank cards, credit cards, or the like. This reference, therefore, not only fails to teach any form of optical memory but also fails to discuss or distinguish optical memories from CD-ROMs and optical disks. There is nothing in the reference that discusses these memory storage devices, and therefore the reference cannot and does not form a basis for distinguishing one over the other.

In view of the above, the undersigned attorney for applicant has

conducted a number of telephone conferences with Examiner Davis and has tried to clarify the rejection set forth in paragraph 2 of the Final Action. The Examiner has concurred that the Ritter patent did not disclose optical memories of any type, and that it was not an appropriate reference to be used in the rejection. The Examiner indicated that she would entertain a request to withdraw the Final Action and continue the examination, if a Request to do so was filed.

Accordingly, applicant respectfully requests that the Office Action mailed on December 16, 2003, be withdrawn in its totality as though it had not be previously issued, and that the application either be allowed, with all the claims of record, or that the Examiner issue a new Office Action that sets forth at least one rejection that is supportable by the applied reference or references used.

During a telephone conference with the Examiner, the Examiner informally identified U.S. Published Application No. US 2002/0027837, published on March 7, 2002. This publication to Weber, filed on August 31, 2001, related back to a provisional application filed on September 1, 2000. Such application, therefore, has an effective filing date that, at its earliest, is September 1, 2000. Submitted herewith is the Declaration of Rod Lowenstein, one of the named inventors in this application, declaring that the invention that has been disclosed and claimed in the subject application was conceived significantly prior to September 1, 2000, and, therefore, this prior application is not a reference that can be used against

applicant.

Although withdrawal of the Final Action would leave no rejections of record, the Examiner did mention, during the telephone conferences, U.S. Published Application No. US 2001/0042009 A1, to Montague, which discloses a computer-readable medium product label device and method. The Montague publication was previously cited, for example, at page 2 of the Office Action mailed on March 20, 2003, and this reference has been discussed and distinguished from the invention as defined in the claims of record. For example, Montague is discussed at page 7 of the September 22, 2003 Amendment. It appears, from the extensive disclosure in the Montague publication, that the most relevant embodiment disclosed in that application, as it bears any possible relevance to the subject matter defined in the claims of record, is the schematic illustration shown in Fig. 5 of the published application, that includes a sleeve, substrates, holders, keepers, labels, tethers and the like for the delivery of CD-ROMs. However, as noted in the September 22, 2003 Amendment, Montague's sleeve 110 is secured to a backing 114 that is, in turn, tethered to a product by a tie or tether 75. The tether 75 is not connected to the sleeve 110 itself, so that a significantly more complicated and more expensive construction is contemplated by Montague. Of importance, it is that the side or edge of the sleeve, at 118, is open with the possible result that the CD-ROM 60, or any other

optical memory such as a DVD, can inadvertently separate from or leave the sleeve through the exposed opening or edge. This is to be distinguished from the invention as defined in the claims of record. For example, claim 1 requires that a generally elongate member be attached to the pouch or sleeve itself, with the pouch or sleeve normally being sufficiently selectively closed to prevent movement of the optical memory out of the pouch independently of attachment to the product. In Montague, it is clear that the CD-ROM, notwithstanding the complex system shown in Fig. 5, does not provide a sleeve that is selectively closed. In fact, there is provided a cut-out, at 118 in Fig. 5, in which the CD-ROM 60 is clearly exposed, even when retained within the sleeve. However, in the claims of record the pouch serves as a protective cover for the CD-ROM and protects the CD-ROM from being scratched and/or damaged in any other way during shipment and handling by packers, shippers, customers or the like.

While the currently preferred embodiment contemplates that the entire CD-ROM is enclosed, as shown, for example, in Fig. 6 of the subject application, the invention also contemplates that the objectives of the invention can also be achieved even if small portions of the CD-ROM are exposed, as long as the CD-ROM cannot inadvertently separate from the sleeve.

As suggested, enclosure or encapsulation provides the maximum protection to the CD-ROM, and different degrees of exposure increase the risks of

damage. However, regardless of the degree of exposure suffered by the optical memories, they must be retained within the pouch's protective covering and must be retained within that pouch during manufacture, transit and subsequent handling until such time that a user intentionally removes such a CD-ROM from the pouch for use as directed.

It is respectfully submitted that the claims of record clearly and patentably distinguish over the claims of the applied references, including Montague, and that this application is in condition for allowance.

Early allowance and issuance is, accordingly, respectfully solicited.

*Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted.* COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100.

Date: APRIL 16, 2004

Respectfully submitted,

Lackenbach Siegel LLP  
One Chase Road  
Scarsdale, NY 10583  
Telephone: 914 723 4300  
MG/as

LACKENBACH SIEGEL LLP  
Attorneys for Applicant(s)

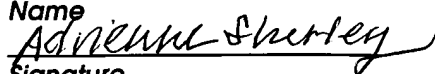
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APRIL 16, 2004

Date